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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,723	05/23/2001	Natasha P. Hixon	4842US	2791

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TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY, UT 84110

EXAMINER

CHOI, STEPHEN

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,723

Applicant(s)

HIXON ET AL.

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 and 24-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16 and 24-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 12-13, 16, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lo (US 5,617,785).

Lo discloses all the recited elements of the invention including:

- a) a first member including an uninterrupted planar die receiving surface (at 40) and a die retaining element associated with the die receiving surface (40), the die retaining element being configured to secure a planar surface of a substantially planar die (80) to the die receiving surface;
- b) a second member including an uninterrupted planar sheet supporting surface oriented to oppose the die receiving surface (at 90);
- c) handles associated with the first and second members so as to facilitate movement of at least one member of the first and second members toward the other of the first and second members (30, 120).

Regarding claim 13, the element 40 is magnet. Regarding claim 24, the die receiving surface (at 40) is unbounded.

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3. Claims 31-32 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Mercorelli (US 3,372,482).

Mercorelli discloses all the recited elements of the invention including:

- d) an uninterrupted, planar die receiving surface (inner surface of a channel 18);
- e) a die retaining element associated with the die receiving surface (at 18);
- f) a substantially planar die (21);
- g) a sheet supporting surface (at 20);
- h) handles (14, 15).

Regarding claim 32, side surfaces of 21 which fit into the channel 18 are uninterrupted and planar, and are completely supported by the die receiving surface (at 18).

4. Claims 31-34 and 36-37 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/51533 (hereinafter '533).

'533 discloses all the recited elements of the invention including:

- i) an uninterrupted, planar, unbounded die receiving surface (end surface of a threaded shaft at 14);
- j) a die retaining element associated with the die receiving surface (threaded shaft at 14);
- k) a substantially planar die (16);
- l) an uninterrupted and planar sheet supporting surface (18);
- m) handles (20).

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Regarding claim 32, an inner end surface of 16 receiving the threaded shaft is uninterrupted and planar, and are completely supported by the die receiving surface (the end surface of a threaded shaft at 14). Regarding claim 36, 18b.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (US 5,617,785) in view of Fink et al. (US 4,574,693).

Lo discloses the invention substantially as claimed except for mechanically securing the planar die. Fink discloses means for mechanically securing a planar die to a die receiving surface (76). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lo to mechanically secure the planar die to the die receiving surface as taught by Fink as an alternative means for securing the die.

7. Claims 15 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (US 5,617,785) in view of Sabin (US 5,172,622).

Lo discloses the invention substantially as claimed except for a cushioning element. Sabin discloses a cushioning element (22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a

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cushioning element as taught by Sabin on the device of Lo in order to minimize wear on an edge of the die.

8. Claims 25-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo.

Lo discloses the invention substantially as claimed except for the die receiving surface configured to completely support a planar back side of a substantially planar die. Figure 5 of Lo appears to show the die being sized to extend beyond a periphery of the die receiving surface. However, one having ordinary skill in the art would have been motivated to provide a different size of the die for a different embossing operation (e.g., a die having size to be completely supported by the die receiving surface) since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). It is noted that the proposed modification would not change the principle of operation of Lo's device.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over '533 in view of Benson et al. (US 5,660,105).

'533 discloses the invention substantially as claimed except for the die retaining element being one of a magnetic and a magnetically-attractable material. Benson teaches use of a magnet to retain a die. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a magnet as taught by Benson on the device of '533 in order to facilitate attachment of the die.

Response to Arguments

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10. Applicant's arguments filed 13 September 2004 have been fully considered but they are not persuasive.

With respect to claim 12, applicants contend that Lo fails to disclose a surface that supports a sheet of material into which a die is to be forced and handles associated with first and second members, and a planar sheet supporting surface that is oriented to oppose a die receiving surface.

The examiner respectfully disagrees. Lo does disclose a sheet supporting surface (at 90) which is oppositely oriented to the die receiving surface in such a way that the die is forced against the sheet material. Furthermore, although the drawings in the Lo reference show a planar surface on the element 90, applicants appear to argue that an embossing die cannot be planar. However, the statement is incorrect. A cooperating embossing die having a planar surface is known in the art. One example of such a die is disclosed in the reference to Jaffin et al. (US 2,005,340). Moreover, the element 30 can be held by a hand of a user; thus, Lo does disclose the handles associated with the first and second members.

11. Applicant's arguments with respect to claims 25-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The examiner respectfully suggests applicants to further define the structure of the planar die, the retaining element, and the die receiving surface including the structural relationship between these elements, and the characteristics of the sheet supporting surface.

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13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Friday 9:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC
9 December 2004



STEPHEN CHOI
PRIMARY EXAMINER